

208437US0DIV



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

VOLKER BENZ ET AL.

SERIAL NO: 09/854,604

FILED: MAY 15, 2001

:

: GROUP ART UNIT: 1774

:

: EXAMINER: FERGUSON, L.

#10
JUL 16 2003
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TC 1700

FOR: PLASTIC COMPOSITES MADE
FROM INCOMPATIBLE PLASTICS

PETITION UNDER 37 CFR 1.181

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

Applicants hereby petition under 37 CFR 1.181 from the Examiner's refusal to
withdraw a premature final rejection and to enter an amendment filed in response to the
rejection. See MPEP 706.07(c).

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STATEMENT OF FACTS

In a first Office Action, entered January 16, 2003, the Examiner rejected Claim 9, the
sole claim in the application at that time, on two different prior art references, not relevant to
this Petition.

In an amendment filed February 11, 2003, Applicants added a new Claim 10, but did
not amend Claim 9.

In a Final Office Action entered April 9, 2003, the Examiner rejected Claim 10 over
newly-applied prior art. In addition, the Examiner rejected Claim 9 over different, newly-
applied prior art. (It is noted that the newly-applied prior art against Claim 9, i.e., U.S.
5,342,189, was **not** filed in an Information Disclosure Statement.) In this Office Action, the

Examiner stated, at paragraph 8 thereof, that Applicants' amendment necessitated the new grounds of rejection therein.

In an amendment filed June 2, 2003, Applicants added new claims, and additionally, traversed the finality of the Office Action, on the grounds that all the new rejections were not necessitated by Applicants' amendment filed February 11, 2003.

In an Advisory Action entered June 18, 2003, the Examiner indicated that the amendment filed June 2, 2003, would not be entered, for various reasons. The Examiner, however, did not respond to Applicants' traversal of finality of the Office Action entered April 9, 2003.

In view of the above, the present Petition is now timely.

ARGUMENT

All the new rejections were not necessitated by Applicants' amendment. Indeed, Claim 9 was not amended at all, yet a new ground of rejection was made thereof. This was improper, as set forth in MPEP § 706.07(a), which reads in pertinent part:

[A] second or any subsequent action on the merits . . . **will not** be made final if it includes a rejection, on newly cited art, . . . **of any claim not amended** . . . in spite of the fact that other claims may have been amended to require newly cited art.

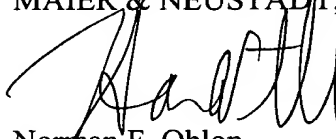
(Emphasis added.)

The above quoted passage from MPEP § 706.07(a) is mandatory. Accordingly, it is respectfully requested that the finality of the Office Action entered April 9, 2003, be vacated,

that the amendment filed June 2, 2003 be entered, and that examination of the application resume for consideration of that amendment on the merits.

Respectfully submitted,

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Applicants: Volker BENZ, et al.
Filing Date: May 15, 2001
For: PLASTIC COMPOSITES MADE FROM
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Group Art Unit: 1774
Examiner: L. Ferguson

SIR:

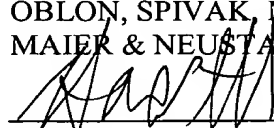
Attached hereto for filing are the following papers:

PETITION UNDER 37 CFR 1.181

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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